PATENT
8013-1155-1

IN THE U.S. PATENT AND TRADEMARK OFFICE

In re application of

Gaku HARADA et al. Conf. 7405

Application No. 10/716,672 Group 1795

Filed November 20, 2003 Examiner Cynthia Lee

ELECTRODE USING IMPROVED ACTIVE MATERIAL
FOR BATTERY AND CAPACITOR

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Assistant Commissioner for Patents January 31, 2008
P.O. Box 1450
Alexandria, VA 22313-1450

Applicants request a pre-appeal brief review of the final rejection in the above-identified application. No amendments are being filed with this request.

A Notice of Appeal is filed herewith.

The review is requested for the reasons advanced on the attached sheets.

Respectfully submitted,

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REASONS IN SUPPORT OF REQUEST FOR REVIEW

A pre-appeal brief review is respectfully requested because the rejections include at least a clear factual error, or in the alternative, a clear legal error, as explained below.

Claims 1, 4-6, and 11-15 are not anticipated by HIRAI et al. JP 61-206170 ("HIRAI").

The English abstract is offered for teaching polymers of diphenyl amine. The underlying Japanese document is offered for teaching diphenyl amine formulas (1) - (4) on page 352, and that "the polymer is doped with perchloric acid" on page 353.

MPEP 706.02II clearly sets forth that reliance on a non-English language document when an English language translation is provided for only the abstract is improper. Accordingly, a full English language translation of HIRAI was requested in response to the Non-final Office Action so that the record would be clear as to the precise facts the Examiner is relying upon in support of the rejection. However, the Examiner denied this request, and issued a final Office Action.

Consequently, the record remains unclear. Indeed, the precise facts relied upon in support of rejection are not clear. There is no explanation offered as to how page 353 teaches a dopant, i.e., "the polymer is doped with perchloric acid". There is also no explanation of how the "dimer" structures of page 352 are interpreted as a "polymer".

Moreover, the Examiner fails to explain the discrepancies between the teachings of the abstract and the underlying document. The abstract does not teach a dopant, but the underlying document apparently does. The abstract discloses a "polymer" of diphenyl amine, but the underlying document appears to be limited to its "dimer". It is for such discrepancies that MPEP 706.02II requires a translation.

Therefore, the rejection cannot be maintained.

Claims 1, 4-6 and 11-15 are not obvious over KOBAYASHI et al. U.S. 4,740,436 ("KOBAYASHI").

KOBAYASHI is offered for teaching a non-aqueous secondary battery comprising a polymer of aniline derivative that is doped with an acid, such as hydrochloric acid.

The position of the Examiner is that one of ordinary skill in the art would have recognized poly(diphenylamine) as one of a relatively small number of polymers disclosed by KOBAYASHI.

However, KOBAYASHI fails to explicitly teach polybiphenylaniline. Indeed, of the aniline compounds used to form the polymers or copolymers, KOBAYASHI especially prefers aniline. See, e.g., column 2, lines 25-68 and the Examples of KOBAYASHI. Thus, KOBAYASHI fails to recognize the superior results of the claimed invention of independent claims 1 and 4.

The present specification demonstrates that the claimed invention has superior performance compared to a conductive

polymer comprising the especially preferred polyaniline of KOBAYASHI. For example, Figure 2 demonstrates that the claimed invention, e.g., Example I, provides a voltage-discharge capacity substantially greater than KOBAYASHI's polyaniline-based polymer, e.g., Comparative Example 1, shown in Figure 3. Additionally, Figure 4 demonstrates that the capacity-discharge current of the claimed invention is superior. Moreover, the ratio of capacity to initial capacity decreases more significantly with the number of cycles for KOBAYASHI's polyaniline-based polymer, compared to the claimed invention, as shown in Figure 5.

Therefore, KOBAYASHI cannot render obvious the claimed invention.

Claims 7 and 8 are not obvious over HIRAI in view of PIENIMAA et al. U.S. 6,110,563 ("PIENIMAA").

For the reasons discussed above with respect to the anticipation rejection, the record is not clear as to the precise facts the Examiner is relying upon in support of HIRAI teaching the features of the independent claims 1 and 4.

PIENIMAA is offered for teaching an electromagnetic shielding that is prepared using a conductive polymer such as polyaniline. However, regardless of the ability of PIENIMAA to teach that for which it is offered, PIENIMAA fails to teach the features of the independent claims or clarify the record with respect to the teachings of the HIRAI abstract and document.

Therefore, the proposed combination cannot render obvious the claimed invention.

Claims 9, 10 and 16-18 are not obvious over HIRAI in view of KATHIRGAMANATHAN et al. U.S. 4,992,559 ("KATHIRGAMANATHAN").

For the reasons discussed above with respect to the anticipation rejection, the record is not clear as to the precise facts the Examiner is relying upon in support of HIRAI teaching the features of the independent claims 1 and 4.

KATHIRGAMANATHAN is offered for teaching that electroconductive polymers can have many uses. However, regardless of the ability of KATHIRGAMANATHAN to teach that for which it is offered, KATHIRGAMANATHAN fails to teach the features of the independent claims or clarify the record with respect to the teachings of the abstract and underlying document of HIRAI.

Therefore, the proposed combination fails to render the claims obvious.

Claims 7 and 8 are not rendered obvious over KOBAYASHI in view of PIENIMAA.

KOBAYASHI is offered for the same reasons discussed above. The Examiner recognizes that KOBAYASHI fails to teach using a conductive polymer as electromagnetic shielding material.

PIENIMAA is offered for the reasons discussed above. However, regardless of the ability of PIENIMAA to teach that for

which it is offered, PIENIMAA fails to remedy the deficiencies of KOBAYASHI for reference purposes. PIENIMAA fails to disclose or suggest the claimed conductive polymer, as well as the superior results as discussed above.

Therefore, the proposed combination cannot render obvious the claimed invention.

Claims 9, 10 and 16-18 are not obvious over KOBAYASHI in view of KATHIRGAMANATHAN.

KOBAYASHI is offered for the reasons discussed above, and the Examiner recognizes that KOBAYASHI does not teach that the conductive polymer can be used in other devices.

KATHIRGAMANATHAN is offered for the reasons discussed above. However, regardless of the ability of KATHIRGAMANATHAN to teach that for which it is offered, KATHIRGAMANATHAN fails to remedy the deficiencies of KOBAYASHI for reference purposes. PIENIMAA fails to disclose or suggest the claimed conductive polymer, as well as the superior results as discussed above.

Conclusion

As shown above, the rejections of record include clear factual and/or legal errors and should be withdrawn and this application allowed, and such is respectfully requested.